

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE *4/25/00*

In re Application of:)

Charles R. SLATER)

Serial No.: 09/177,502)

Filed: October 23, 1998)

For: BIPOLAR ENDOSCOPIC)
SURGICAL SCISSOR BLADES)
AND INSTRUMENT)
INCORPORATING THE SAME)

Group Art Unit: 3736

Examiner: M. PEFFLEY

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE

This is in response to the Office Action dated December 13, 1999, rejecting all of the pending claims 24-29 and 40-56 directed to a particular type of blade (the "blade" claims). As set forth below, the Examiner's rejection is directly contrary to the proper legal result. There is no "disclaimer" or "estoppel" because the very issue of whether there could be an interference on applicant's blade claims was placed squarely before the Administrative Patent Judge (APJ), who decided against Rydell (applicant's opponent in Interference No. 103,765) on the ground that Rydell could not make those claims because they were unpatentable to Rydell. An interference is only possible if both parties can "make" the claims. Rydell did not reserve the right to challenge the APJ's decision at final hearing, although given an opportunity to do so, and did not attempt to overturn the decision at final hearing. Thus, the judgment in the '765

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